

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER E. SCOTT

Appeal No. 1997-1498
Application 08/251,148¹

ON BRIEF

Before METZ, PAK, and WALTZ, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 17 and 19 through 21, which are all of the claims pending in the

¹ Application for patent filed May 31, 1994.

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application.

According to appellant (Brief, page 2), "[t]he claims stand or fall together." Therefore, we select claim 1, the broadest claim in this application, as the representative claim upon which we will decide this appeal consistent with 37 CFR § 1.192(c)(7) and (c)(8) (1995). Claim 1 is reproduced below:

1. A visually clear blend of thermoplastic polymers comprising a polyetherimide and a polyester of (a) an acid component comprising 2,6-naphthalene dicarboxylic acid and (b) a glycol component comprising at least one glycol selected from the group consisting of ethylene glycol, 1,3-trimethylene glycol, 1,4-butanediol, 1,5-pentanediol, 1,6-hexanediol, 1,7-heptanediol, neopentyl glycol, 1,4-cyclohexanedimethanol and diethylene glycol, wherein the amount of said 2,6-naphthalene dicarboxylic acid in the acid component is greater than about 30 mol% when 1,4-cyclohexane-dimethanol is present in said glycol component.

The sole prior art reference relied upon by the examiner is:

Minnick	5,284,903	Feb. 8, 1994
		(Filed Dec. 23, 1992)

The appealed claims stand rejected as follows²:

² The examiner has withdrawn the rejection of claims 3 through 17 and 19 through 21 under 35 U.S.C. § 112, second paragraph, set forth in the final Office action and the

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(1) Claims 1 and 2 under 35 U.S.C. § 112, first paragraph, as lacking descriptive support for the invention presently claimed; and

(2) Claims 1 through 17 and 19 through 21 under 35 U.S.C. § 103 as unpatentable over the disclosure of Minnick.

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and appellants in support of their respective positions. This review leads us to conclude that only the examiner's § 112 rejection of claims 1 and 2 is well founded. Accordingly, we affirm the § 112 rejection of claims 1 and 2, but reverse the § 103 rejection of claims 1 through 17 and 19 through 21. Our reasons for this determination follow.

Rejection under 35 U.S.C. § 112, First Paragraph

The examiner has rejected claims 1 and 2 under 35 U.S.C. § 112, first paragraph, as lacking descriptive support in the application disclosure as originally filed for the subsequently added limitations in claims 1 and 2. According

Answer. See the Answer to the Reply Brief dated August 21, 1996, Paper No. 16.

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to the examiner (Answer, page 3), "[t]he specification, as originally filed, does not provide express support for the 'greater than about 30 mol%' limitation added to claim 1." On the other hand, appellants argue (Brief, page 3) that:

On November 9, 1994, claim 1 of the present invention was amended to recite "wherein the amount of said 2,6-naphthalene dicarboxylic acid in the acid component is greater than about 30 mol% when 1,4 cyclohexane-dimethanol is present in said glycol component". Table 1, on page 12 of the application shows that the clear compositions which contain CHDM (G1, H1, I1, J1, and K1) have 32, 34, 66 and 100 mol% 2,6-naphthalenedicarboxylic acid (NA), respectively. The amount of NA in G1 (32 mol%) is clearly about 30, and 34, 66 and 100 are clearly greater than about 30 mol %. Thus, the specification (specifically compositions G1-K1 of Table 1) clearly support the November 11, 1994 amendment. Reversal of the rejection based upon 112 is requested.

The purpose of the "written description requirement of 35 U.S.C. § 112, first paragraph, is to ensure that applicants had possession, as of the filing date of the application relied on, of the subject matter later claimed by them. *In re Blaser*, 556 F.2d 534, 537, 194 USPQ 122, 124-25 (CCPA 1977). Satisfaction of the "written description" requirement does not require that the subject matter later claimed be described in exactly the same terms in the application as

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originally filed. *Vas-cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991); see also *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976) ("lack of literal support... is not enough... to support a rejection under 112"). The test is whether the application disclosure as originally filed reasonably conveys to one of ordinary skill in the art that applicants had possession of the presently claimed subject matter. *Ralston Purina Co. v. Far-Mar-Co. Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985); *In re Smythe*, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973).

The dispositive question here is, therefore, whether Table 1 at page 12 of the specification reasonably conveys to one of ordinary skill in the art that appellants had possession of the newly added limitation "wherein the amount of said 2, 6-naphthalene dicarboxylic acid in the acid component is greater than about 30 mol% when 1,4 cyclohexane-dimethanol is present in said glycol component" in claim 1. We answer this question in the negative.

The examiner finds, and appellants do not dispute, that the application disclosure as originally filed does not provide literal support for employing greater than about 30 mol% of 2, 6-naphthalene dicarboxylic acid. As indicated by appellants (Brief, page 3), the examples and Table 1 in the specification show visually clear blend of thermoplastic polymer compositions containing 32, 34, 66 and 100 mol% of 2,6-naphthalenedicarboxylic acid, respectively, together with 1, 4 cyclohexane-dimethanol. Although these examples and Table 1 provide descriptive support for employing "greater than about 32 mol% of 2,6-naphthalenedicarboxylic acid" in a visually clear blend of thermoplastic polymer compositions, *see Ex parte Jackson*, 110 USPQ 561 (Bd. App. 1956), they do not provide descriptive support for employing "greater than about 30 mol% of 2, 6-naphthalenedicarboxylic acid" in a visually clear blend of thermoplastic polymer compositions, *see Blaser*, 556 F.2d at 537, 194 USPQ at 125. It may very well be true that the term "about 30 mol%" is inclusive of "32 mol%" of 2,6-naphthalenedicarboxylic acid as argued by appellants. What is equally true, however, is that

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the term "about 30 mol%" is also inclusive of "28 to 30 mol%" of naphthalenedicarboxylic acid, which are not described in the application disclosure as originally filed within the meaning of 35 U.S.C. § 112, first paragraph. *Id* at 537, 194 USPQ at 125. Accordingly, we affirm the examiner's decision rejecting claims 1 and 2 under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 103

The examiner has rejected claims 1 through 17 and 19 through 21 under 35 U.S.C. § 103 as obvious over the disclosure of Minnick. See the Answer, page 4. In order to establish a *prima facie* case of obviousness under Section 103, the examiner must supply some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art that would have led the artisan to

the claimed invention, without recourse to the teachings of

appellants' disclosure. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992)(Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-75, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988). The burden of producing a factual basis to support a *prima facie* case of obviousness rests on the examiner. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967).

The claimed subject matter is directed to "a visually clear blend of thermoplastic polymers" comprising a polyetherimide and a polyester of an acid component comprising 2, 6-naphthalene dicarboxylic acid and a glycol component comprising 1, 3-trimethylene glycol, 1, 4-butanediol, 1, 5-pentanediol, 1,6-hexanediol, 1, 7-heptanediol, neopentyl glycol, 1,4-cyclohexane-dimethanol and diethylene glycol. *See, e.g.,* claim 1. When 1, 4-cyclohexane dimethanol is used as a glycol component, the amount of 2, 6-naphthalenedicarboxylic acid in the acid component is at least about 30 mol%. *Id.* Moreover, according to Table 1, on page 12 of the specification, to obtain "a visually clear blend of thermoplastic polymers", not

only are the specific ingredients recited in the claims on appeal required, but also

specific proportions of those ingredients are necessary. In other words, the limitation "a visually clear blend of thermoplastic polymers" limits the claimed compositions to those compositions having only those specific proportions of the claimed ingredients, which are capable of forming a visually clear blend of thermoplastic polymers.

As found by the examiner, Minnick discloses polymer blends comprising a polyetherimide and at least one polyester resin derived from a cyclohexanedimethanol and a carbocyclic acid or ester. See column 1, lines 50-55. The carbocyclic acid, according to Minnick, generically refers to any organic compound whose carbon skeleton forms at least part of a closed ring. See column 5, lines 40-46. Although Minnick indicates that iso and terephthalic acids are the preferred carbocyclic acids (see column 3, lines 15-20 and columns 7 and 8, example 2 and the Table), it also mentions 2, 6-naphthalenedicarboxylic acid as one of the carbocyclic acids useful for forming a polyester resin (see column 5, lines 53-

66).

Although Minnick generically describes polymer blends having the claimed ingredients, it does not provide any guidance of forming the claimed visually clear blend of thermoplastic polymers. We agree with appellants that:

Minnick is silent as to visual clarity [regarding its polymer compositions] and in fact, Minnick's preferred composition (100 mol% CHDM/100 mol% T) is cloudy.³

We also observe that Minnick does not recognize specific proportions of 2, 6-naphthalene dicarboxylic acid in the acid component of a polyester as a result effective variable for forming a visually clear blend of thermoplastic polymers. See Minnick in its entirety. On this record, we are constrained to agree with appellants that Minnick would not have rendered the claimed subject matter *prima facie* obvious to one of ordinary skill in the art. Accordingly, we reverse the

³ See Minnick in its entirety in conjunction with Table 1 on page 12 of the specification.

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examiner's decision rejecting claims 1 through 17 and 19
through 21 under 35 U.S.C. § 103.

In view of the foregoing, the decision of the examiner is
affirmed-in-part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

ANDREW H. METZ)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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